

REMARKS

The present invention relates to a method for manufacturing bleached mechanical and chemithermolmechanical pulp.

In the Office Action of June 28, 2005, the Abstract of the Disclosure was objected to because of use of the term “said” and because the length exceeded 150 words. Also, corrections in the specification were required at pages 7 and 13 with respect to misspelled terms. Claim 5 was objected to because of a misspelling.

At pages 3-5 of the Office Action, claims 1-13 were rejected under 35 U.S.C. § 112, first paragraph with respect to the enablement requirement and under the second paragraph for indefiniteness. Particularly, the Examiner indicated questions about enablement with respect to the claim recitations “drastic conditions from the aspect of temperature” and “minimized oxygen access”. The Examiner similarly raised indefiniteness questions with respect to such terminology, and furthermore with respect to the terminology “very high” and “low” in claim 11. At pages 5-10 of the Office Action, claims 1-7 and 11-13 were rejected under 35 U.S.C. § 103(a) based on the alleged admitted prior art in view of the previously cited Madison, West, and Grimsley et al references, based on reasonings similar to the previous rejections under 35 U.S.C. § 103 by the previous Examiner. At pages 11-12 the Examiner responded to Applicants’ arguments distinguishing over the references, including indicating that certain recitations were

not given patentable weight (e.g., preferably wood in chip form”), and that certain distinguishing features were not recited in the rejected claims.

It is appreciated that the Examiner indicated that claims 8-10 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph to include all the limitations of the base claim and the remaining claims.

In response to the Office Action, it is first noted that the specification has been amended at pages 7 and 13 to make the corrections suggested by the Examiner.

The Abstract has been rewritten to avoid use of the term “said” and to reduce the length of the Abstract to less than 150 words.

In the claims, claim 5 has been amended to overcome the objection based on the noted informality. Further to the Examiner’s recognition of the patentability of claims 8, 9, and 10, claim 8 has been amended to independent form. It is noted that claims 9 and 10 depend on independent claim 8.

Turning to the rejections under 35 U.S.C. § 112, with respect to the enablement issue, it is respectfully submitted that the temperature and minimized oxygen access conditions recited in independent claim 1 would be clearly understandable and enabled to a person skilled in the art

based on the specification and the examples, including by reference to the specific example embodiments described at pages 13-17.

With respect to the indefiniteness rejection of the claims with respect to the same terminology as noted above, the same disclosure in the specification would render the meaning definite to a person skilled in this art. With respect to claim 11, it must be noted that indication that the temperature is “very high” is qualified by the further recitation “from a bleaching aspect”, and the indication that the solid content or concentration is “low” would be understood to be in the context of what would be normal at the location.

Accordingly, it is respectfully submitted that the present claims comply with the requirements of both the first and second paragraphs of 35 U.S.C. § 112.

With respect to the prior art rejection of claims 1-7 and 11-13 under 35 U.S.C. § 103(a) based on the asserted combination of alleged admitted prior art the Madison reference, the West reference, and Grimsley et al reference, Applicants respectfully submit that the art would not and could not be combined in the manner asserted by the Examiner by person of ordinary skill in the art even with knowledge of the references and knowledge of what was known in the art. It is only by hind sight reconstruction that such a conclusion can be reached.

The Examiner has referred to MPEP 2129 with respect to the consideration of what is admitted prior art based on the use of the Jepson claim format. However, the combination of known feature with features that have not been used together therewith previously can and in the present case does constitute novel and unobvious combination.

The Examiner has recognized that the admitted prior art based on Jepson preamble recitation does not include disclosure of expressly adding bleaching agent at a location downstream of the most downstream refiner, and upstream of the screening department. Furthermore, the Examiner has recognized that the bleaching of the pulp under the drastic conditions from the aspect of temperature and the given minimized oxygen accessed at the location and immediately downstream of the location are not known in the admitted prior art.

Furthermore, with respect to the secondary and tertiary references cited by the Examiner, the Examiner has recognized that the Madison et al reference does not disclose expressly bleaching the pulp under the claim-required drastic condition with respect to temperature and minimized oxygen access at the noted location and immediately downstream thereof. The Examiner has also recognized that the West reference does not disclose expressly minimized oxygen access at the noted location and immediately downstream thereof. However, although the Examiner desires to rely on Madison et al with respect to disclosure to adding bleaching agent of the location downstream of a downstream refiner and upstream screening department, and although the Examiner relies on the West reference as disclosing bleaching pulp under

drastic conditions and temperature, the Examiner must furthermore rely on third reference to defined all features recited in claim 1, viz., the Examiner relies on Grimsley et al as disclosing minimized oxygen access at the noted location immediately downstream thereof.

What is lacking however, is an explanation is how a person of ordinary skill in the art would be lead to choose just those select features of the secondary and tertiary references, while ignoring other disclosure of said references, to arrive at the presently claimed invention. There is no basis in the teachings that would lead a person of ordinary skill thereto. Thus, it is only hindsight that leads to a conclusion of obviousness.

Accordingly, withdrawal of the rejection of the claims 1-7 and 11-13 is respectfully submitted to be proper.

Referring to the Examiner's indication at page 13 that the subject matter of claims 8-10 would be allowable if properly rewritten, Applicants' have herein amended claim 8 to incorporate subject matter of the claim from which claim 8 depended directly or indirectly, viz., claims 7 and 1, respectfully. Thus, claim 8 is now in independent form and claims 9 and 10 depended thereon, are respectfully submitted to be in condition for immediate allowance.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/914,650

Attorney Docket No.: Q66048

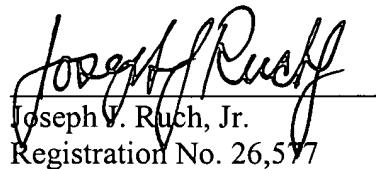
In view of the foregoing amendments to the specification and claims, and foregoing remarks, Applicants respectfully submit that the present application is now in condition for immediate allowance.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby earnestly solicited.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the local Washington, D.C. telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Joseph V. Ruch, Jr.
Registration No. 26,577

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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